

PATENT
7251/78746



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: WACHTFOGEL et al.)
For: ADVANCED TELEVISION SYSTEM)
Serial No.: 09/515,118)
Filed: 24 February 2000)
Art Unit: 2623)
Examiner: James R. SHELEHEDA)

APPELLANTS' REPLY BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Dear Sir or Madam:

This is a reply to the Examiner's Answer mailed 12 September 2007.

1. **Neither of the Two Cited References Discloses Presenting Other Commercials in Response to a User Request With Respect to the At Least One of the Commercials.**

The Examiner's Answer makes two arguments with respect to independent claim 132. Both of those arguments are flawed. One of those arguments inconsistently treats the claimed "said one commercial" as only the first of the "at least one of said commercials" for one purpose, but as all of the "at least one of said commercials" (assuming *arguendo* that there are subsequent commercials) for another purpose. The other of those arguments treats claim 132 as reading on everything encompassed by the supporting text in the specification. Neither of those arguments is justified.

The next to last paragraph on page 6 of the Examiner's Answer concedes that Alexander does not disclose the claim limitation in issue. Alexander does not even address dealing with user requests to view programming in general, let alone a commercial in particular, in fast forward/backward. As discussed below and in Appellant's initial brief, Akiba also does not disclose the claim limitation in issue. Akiba is about fast forward/backward in general, and is concerned with easing eye strain. Like Alexander, Akiba also does not address dealing with a user request to view a commercial in particular in fast forward/backward, except to skip the entire commercial if it is too short relative to the sampling interval for the Akiba screen blending to ease eye strain (Akiba Abstract; 4:32-37). Therefore, neither of the two cited references discloses presenting other commercials in response to a user request with respect to the at least one of the commercials.

No reason has been articulated, and there is no reason, to combine the two references to address a subject with which neither reference is concerned.

However, even if they are combined, neither reference discloses the claim limitation in issue.

It is noted that the bottom of page 9 of the Examiner's Answer purports to quote from claim 132. What is written is a misquote, and reference should be made instead to the claim itself.

a. **Examiner's Answer Conflates a First One of the At Least One of Said Commercials That a User Requests to View in Fast-Forward with All of Them**

In claim 132, "said commercials" refers to the commercials being broadcast that are introduced in the preamble. As explained in Appellants' initial brief, the "said one commercial" mentioned twice in the "wherein" limitation of claim 132 necessarily refers to something previously introduced in the claim because it is preceded by "said". What it refers to is the "at least one of said commercials" introduced at the beginning of the "wherein" limitation. On the other hand, the claim term "other commercials" is not preceded by "said" or by "the", and necessarily refers to something not previously introduced in the claim. The claim term "other commercials" necessarily refers to something different than the at least one of the commercials that the user has requested to view in fast-forward or fast-backward mode.

Akiba does not disclose a series of commercials (either at fast or at normal speed). However, assuming *arguendo* there were a series of Akiba commercials, the second paragraph on page 9 of the Examiner's Answer states that "the user command would be a request to fast-forward through the first commercial (the one) and the subsequent commercials...." Assuming *arguendo* there were a series of Akiba commercials, the user command would be a request to fast-forward

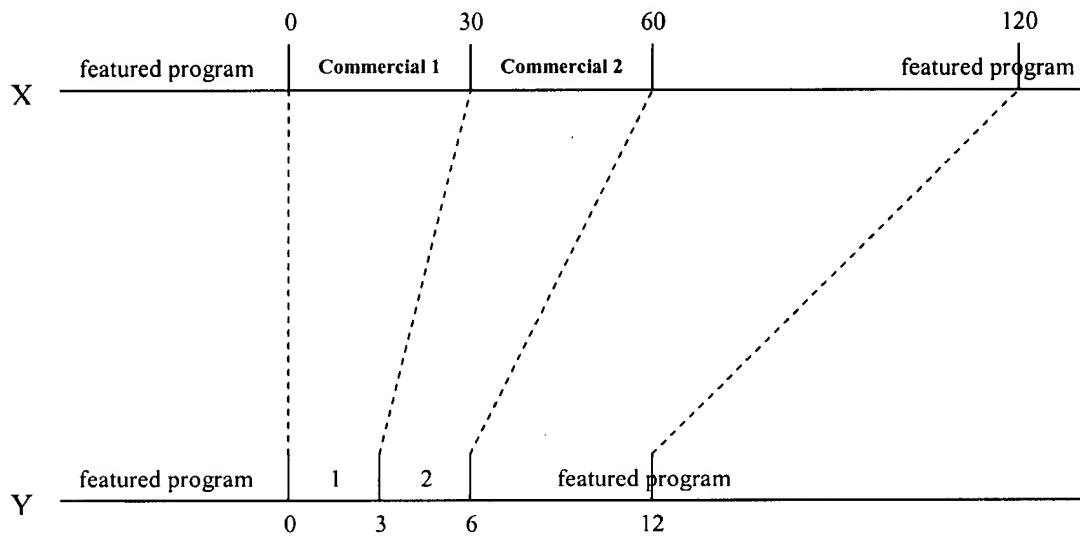
through the first and the subsequent commercials until the user withdrew the request. However, the claimed “other commercials” must be different commercials than the at least one of the commercials (i.e., including the subsequent commercials assuming there were any) that the user has requested to view in fast-forward. The Examiner’s Answer concedes that the user would have requested to fast-forward any subsequent commercials, and then erroneously argues that they are different than and not among those commercials that the user has requested to view in fast-forward mode.

Assuming *arguendo* that there were a series of Akiba commercials, to the extent that only the first is considered the at least one of said commercials for which the user has requested fast-forward, then the Akiba response is only to present a shortened version of that same first commercial. A shortened version of a second commercial comes only in response to the continued user request for fast-forward during the broadcast of that same second commercial. Akiba discloses only a way of presenting a fast-forward version of whatever programming the viewer requests to view in fast-forward, and never substitutes a short version of a different commercial in place of the one(s) for which the user requests fast-forward.

The following diagram is presented solely as a possible example to illustrate what is discussed above. In this example, line X represents the programming that would be presented absent a user request for fast-forward. There is a featured program, a commercial 1 beginning at point 0, followed by a commercial 2 at point 30, followed by resumption of the featured program at point

60. In this example, there is a user request for fast-forward between point 0 and point 120.

Line Y illustrates the response in accordance with the Akiba disclosure, assuming *arguendo* there were a series of Akiba commercials. Assuming the commercials were not skipped entirely, the programming from points 1 to 120 would be shown fast by deleting most screens. Commercial 1 would be seen between points 0 and 3 on line Y, commercial 2 would be seen between points 3 and 6 on line Y, and the resumption of the featured program from points 60 to 120 on line X would be seen in a fast version between points 6 and 12 on line Y.



The Examiner's Answer inconsistently treats the claimed "said one commercial," on the one hand, as a series of commercials requested to be viewed in fast-forward to which Akiba is allegedly responding by presenting shortened versions and, on the other hand, as only a first such commercial for the purpose of

distinguishing the claimed “other commercials.” However, the claimed terms have to be applied consistently to determine whether a claim reads on prior art.

In the context of the example illustrated above, commercial 1 (points 0-30 on line X) might be considered the at least one commercial for which the user has requested fast-forward. In that case, only the fast version of commercial 1 is presented (points 0-3 on line Y) as the response in accordance with the Akiba disclosure. On the other hand, if both commercials 1 and 2 (points 0-60 on line X) are considered the at least one commercial for which the user has requested fast-forward, then the response is the fast versions of commercials 1 and 2 (points 0-6 on line Y). The Akiba response to the user request is to present a fast version of whatever programming would have been presented absent the user request. The Akiba fast version of commercial 2 is *not* presented because of a request to fast-forward through commercial 1, but only if there is a fast-forward request continuing through commercial 2. Akiba does not disclose, and the Examiner’s Answer does not assert that Akiba discloses, presenting alternative shortened versions of other commercials (i.e., not the one(s) that the user has requested to view in fast-forward) as claimed.

b. Examiner’s Answer Conflates the Claim With the Specification

Page 8 of the Examiner’s Answer argues that Appellants’ specification states that a shortened version of a full commercial is displayed (in response to a fast-forward request), and that “[t]his first shortened commercial is not specifically defined as being of an other commercial.” However, that shortened commercial may be a shortened version of the same commercial or of a different commercial. The specification also discloses the presentation of multiple short commercials.

Indeed, there may not even be a “same” commercial, since the specification concerns dealing with a user request for fast-forward during programming “even when the program is a commercial” (32:21), but is not limited to such circumstances in which a commercial would have been presented absent a fast-forward request.

At one time, the application did include a claim for presentation of a shortened version of the same commercial. For example, now cancelled claim 130 stated, “wherein, for at least one of said commercials, said receiver-decoder deals with said one commercial by presenting a shortened version of said one commercial in response to a user request to view said program material in a fast-forward or fast-backward mode.” On the other hand, unlike cancelled claim 130, claim 132 in issue requires the presentation of a shortened version of a different commercial rather than of the same commercial. The scope of each claim is only a subset of what the specification discloses.

The specification encompasses the presentation of a shortened version of the same commercial and the presentation of shortened versions of other commercials. It also encompasses the presentation of shortened commercials during a user request for fast-forward of a commercial, and during a user request for fast-forward during programming that is not a commercial (when there would not even be any “same” commercial). Claim 132 has to be interpreted based on its own language, and does not necessarily read on everything encompassed by the specification.

2. **Neither of the Two References Discloses “Prepared Meaningful Shortened Versions”**

Claim 134 depends from independent claim 132 and requires the shortened versions of other commercials to comprise “prepared meaningful shortened versions.” As discussed in Appellants’ initial brief, Alexander does not discuss shortened commercials, and Akiba does not disclose prepared meaningful shortened versions but rather an automatic selection of screens based on a predetermined interval.

Page 13 of the Examiner’s Answer abandons the rationale of the Final Office Action. Instead, it relies on a portion of Akiba, discussed in Appellants’ initial brief, that provides a scheme by which the sampling of screens based on a predetermined interval is delayed and a commercial is skipped entirely, if the commercial is too short relative to the sampling interval. Akiba’s disclosure of entirely skipping a commercial, that is too short relative to the sampling interval, does not render “prepared” or “meaningful” a commercial that is presented. Any commercial that is presented is still based on an automatic sampling interval. Eliminating the sampling of commercials that are too short in order to prevent a discontinuous and unsatisfactory appearance is part of the Akiba invention. That invention has nothing to do with commercials, *per se*, but with blending from screen to screen to ease eye strain caused by skipping so many screens in a fast forward mode. (Akiba Abstract; 4:32-37).

The Akiba disclosure has nothing to do with presenting “prepared meaningful shortened versions” of commercials. It still discloses only an automatic selection of screens based on a predetermined interval, without any

preparation and without consideration of whether anything meaningful is conveyed.

For the foregoing reasons and those discussed in Appellants' initial brief, favorable consideration of this Appeal and allowance of the captioned application are respectfully requested.

Respectfully submitted,

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